

## REMARKS

The Examiner has issued an Official Action requiring restriction between four groups of inventions. The groups identified by the Examiner are:

Group I: Claims 1-17, 52, 54, 55 and 63 drawn to a composition comprising a polymer, a delivery system formed from said composition and a method of treatment;

Group II: Claims 18-28, 56, 57 and 66-68 drawn to a process for the preparation of a composition;

Group III: Claims 29-40, 53, 58, 59 and 64, drawn to a kit comprising a composition and a device and a method of treatment comprising said kit; and

Group IV: Claims 41-51, 60-62 and 65 drawn to a method of forming *in situ* a delivery system.

This restriction requirement is respectfully traversed.

It is respectfully requested that the claims of Groups I, II and III be examined together in this application. In paragraph 2 of the Official Action the Examiner states "In the instant case the compositions claimed in Group I may be formed by a process comprising the step of dissolving the emulsifier in an aqueous phase, rather than in oil, as claimed in the process of Group II." The Examiner has not provided any support for this statement. Even if the emulsifier could be dissolved in an aqueous phase, the Examiner has not provided any support that the biocompatible polymers can be dissolved in an oil. Furthermore, the Examiner has not provided any support that if the polymer is dissolved in oil, that a polymer droplet-in-oil dispersion could be formed.

The Examiner's attention is drawn to US Patent 5,278,201(Dunn). This patent

includes claims for compositions and pharmaceutical kits. It is submitted that if the claims for the compositions are patentable, then the claims for the kit are patentable.

Therefore, it is respectfully requested that the claims of Groups I, II and III be examined in this application.

If the Examiner does not agree that the claims of Groups I, II and III should be examined together in this application, it is respectfully requested that the claims of Groups I and II or the claims of Groups I and III be examined in this application. If the Examiner does not agree then applicants elect the claims of Group I.

For purposes of the search, a biodegradable polymer is elected and the following species is identified:

Biodegradable polymer: homo-polymers composed of lactic acid/lactide class of monomers and co-polymers from the lactic/glycolic acids and lactide/glycolide class of co-monomers. Lactide and glycolides are dimers derived from lactic and glycolic acids and fall in the same class. In other words these are the polylactides, polylactics, polylactic acid-co-glycolic acid and polylactides-co-glycolides identified as 1, 3, 4 and 5 in paragraph 9 of the Official Action.

The Examiner has identified claims 1, 18, 29 and 41 as generic.

For purposes of the search, the solvent elected is N,N'-dimethylacetamide, polyethylene glycol or a mixture thereof.

For purposes of the search, the biologically active agent elected is an antineoplastic agent and the agent is paclitaxel.

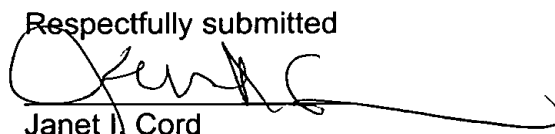
The Examiner has identified claims 7, 24, 25, 35, 46 and 63-68 as generic.

Applicants submit that claims 1, 2, 4-8, 10-19, 21-26, 28-30, 32-37, 39-42, 44-47, are 49-68 are generic to the above-identified species.

Applicants preserve all rights to file one or more divisional applications directed to the subject matter of the non-elected claims and non-elected subject matter.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted



Janet I. Cord  
c/o Laeas & Parry  
26 West 61st Street  
New York, New York 10023  
Reg. No. 33, 778 (212-708-1935)